

## **REMARKS/ARGUMENTS**

Applicants have carefully reviewed the Office Action mailed on October 29, 2008. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. Claims 1 and 3-20 remain pending. Favorable consideration for the amendments and the following remarks is respectfully requested.

### **Claim Rejections under 35 U.S.C § 102**

Claims 1, 3-5, 7, 9-12, 14, 16-18, and 20 remain rejected under 35 U.S.C. 102(e) as being anticipated by Nwawka (U.S. Patent No. 6,036,638). This rejection is respectfully traversed. Nwawka fail to teach the identical structure in the same arrangement as recited in the independent claims, thus the rejection is made in error.

The Examiner asserts that Nwawka teaches an expandable tubular structure 103 and a surgical tool 20 to expand the tubular structure, where the tool includes an elongate body 100 and a first leg 30 and second leg 40. The Examiner appears to have misinterpreted the reference. Nwawka teaches, "speculum 20 comprises a lower arm 30, an upper arm 40, and a pivot mechanism 50" (see column 4, lines 25-26 and FIG. 1), and "vaginal sleeve 100, designed to envelope a conventional bi-valve vaginal speculum 20, comprises sheath 103" (see column 5, lines 42-44, and FIG. 2). Nwawka thus teaches the speculum 20 includes arms 30 and 40, while the vaginal sleeve 100 comprises a sheath 103. The Examiner's reference to a tool 20 that includes an elongate body 100 and a first leg at 30 and a second leg at 40 is not supported by Nwawka. The Examiner appears to be asserting different parts of two separate and distinct devices of Nwawka as meeting the structural elements of a single device as recited in the claims. Applicants submit such an interpretation is improper.

MPEP § 2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not

an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Emphasis added. Applicants submit that Nwawka fail to teach every element arranged as required by independent claim 1, and thus Nwawka cannot be deemed to anticipate the claim. Withdrawal of the rejection is respectfully requested.

Regarding independent claim 10, the Examiner again appears to be equating elements from the vaginal sleeve 100 as being part of the speculum 20. The Examiner asserts that Nwawka teaches an intermediate member 105. The Examiner appears to be asserting that speculum 20 of Nwawka reads on the claimed elongate member, and the vaginal sleeve 100 reads on the claimed expandable tubular structure. However, the Examiner's assertion that Nwawka teach an intermediate member 105 is not supported by the reference. Nwawka teach the vaginal sleeve, including the sheath 103, as further comprising ribs 105. See column 6, line 1 and FIG. 2. The ribs 105 are thus part of the sleeve 100 or sheath 103, and not the speculum 20. As discussed above, an anticipation rejection requires the elements in a reference to be arranged as required by the claim. Nwawka do not appear to recite the identical elements in the same arrangement as recited in independent claim 10, thus the rejection is in error. Withdrawal of the rejection is respectfully requested.

Regarding independent claim 16, and as stated in the previous response, the Office Action does not state which elements of Nwawka teach the limitations of claim 16. Applicants assumed, for the sake of argument, that the limitation of "first and second jaws pivotally connected to the second end of the shaft" occurs at pin 76 of Nwawka, only one jaw (upper arm 40) could be considered to be pivotally connected at pin 76. ("The proximal end 44 of the upper arm 40 is pivotally connected to the first and second pins 74, 76." (Fig. 1; col. 4 lines 63-65).) On the other hand, assuming, for the sake of argument, that the limitation of "first and second jaws pivotally connected to the second end of the shaft" occurs at pivot mechanism 50 of Nwawka, at best only the second jaw (lower arm 30) could be deemed to pivotally connect at pivot mechanism 50. ("The lower arm 30 comprises a blade 32 having a proximal end 34, a distal end 36, and a handle portion 38 which is integrally connected to the proximal

end 34 of the blade 32.” (Fig. 1; col. 4, lines 27-29).) Also, according to claim 16, the handle is pivotally connected to the *first end* of the shaft. The only apparent possible locations for a pivotal connection of a handle, according to Nwawka, would be pin 76 which was previously established to be at the *second end* of the shaft since the first jaw is pivotally connected there, or at pivot mechanism 50 which would also be the *second end* since the second jaw was connected through the handle portion 38. (Fig. 1).

The Examiner has not clarified the rejection, but asserts, that Nwawka teaches “a handle pivotally at 76 which connected to the first end of the shaft and where the first and second jaw pivotally at 74 which connected to the second end of the shaft”. Applicants do not understand this rejection. In particular, the Examiner has not indicated which element of Nwawka is interpreted as being the shaft. Nwawka appears to teach two jaws 30, 40, and two handle portions 38, 90, where handle 90 appears to be integrally formed on jaw 40. The device and elements of Nwawka do not appear to have the identical structure and be in the same arrangement as recited in the claims. Nwawka, therefore, does not appear to teach each and every limitation of claim 16. Withdrawal of the rejection is respectfully requested. If the rejection is not withdrawn, Applicants again respectfully request that the next Office Action be non-final and state which elements of Nwawka teach which limitations of claim 16 so that a proper response may be made.

#### **Claim Rejections under 35 U.S.C § 103**

Claims 6, 8, 13, 15, and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nwawka (U.S. Patent No. 6,036,638) in view of Gerrone (U.S. Patent No. 5,312,351). This rejection is respectfully traversed.

This rejection was repeated from the previous Office Action, but the Examiner has not addressed Applicants’ previous remarks. Those remarks are repeated below. Applicants respectfully request the Examiner withdraw the rejection or provide comments and reasons why the rejection is being maintained.

As mentioned above, Nwawka does not appear to teach each and every limitation of claim 1. Gerrone does not appear to cure the failings of Nwawka. Claim 1, therefore, is believed patentable over Nwawka in view of Gerrone. As claims 6 and 8 depend from claim 1 and add further limitations thereto, Applicants also believe that claim 6 and 8 are patentable over Nwawka in view of Gerrone. Withdrawal of the rejection is respectfully requested.

As mentioned above, Nwawka does not appear to teach each and every limitation of claim 10. Gerrone does not appear to cure the failings of Nwawka. Claim 10, therefore, is believed patentable over Nwawka in view of Gerrone. As claims 13 and 15 depend from claim 1 and add further limitations thereto, Applicants also believe that claims 13 and 15 are patentable over Nwawka in view of Gerrone. Withdrawal of the rejection is respectfully requested.

As mentioned above, Nwawka does not appear to teach each and every limitation of claim 16. Gerrone does not appear to cure the failings of Nwawka. Claim 16, therefore, is believed patentable over Nwawka in view of Gerrone. As claim 19 depends from claim 16 and adds further limitations thereto, Applicants also believe that claim 19 is patentable over Nwawka in view of Gerrone. Withdrawal of the rejection is respectfully requested.

## **CONCLUSION**

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their attorney,

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